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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,042	09/23/2003	Alan Terry Hemphill	HALB:028C1	3992

7590 04/20/2005

Karen B. Tripp
Attorney at Law
P.O. Box 1301
Houston, TX 77251-1301

EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,042

Applicant(s)

HEMPHILL, ALAN TERRY

Examiner

Zakiya N. Walker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09232003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the term "is disclosed" is stated in line 1. Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wars et al., Charlez et al. (both cited by applicant).

Each reference discloses a method that includes a method for removing built-up drill cuttings from a borehole, said method comprising employing a sweep wherein said sweep is selected as the more efficient sweep from a group of sweeps tested in real time at the wellsite using pressure-while-drilling data and calculations of sweep efficiency. With respect to claims 9 and 10, the references teach calculations of sweep efficiency with ECD, and the more efficient sweep is the one that results in the greater recovery of drill cuttings. With respect to claim 11, each reference teaches a real time method for measuring efficiency of a sweep in removing cuttings from a borehole penetrating a subterranean formation, said method comprising: determining the mass in of the sweep; using real time pressure-while-drilling tool data in determining the mass out of the sweep', and subtracting at the borehole site the mass in of the sweep from the mass out of the sweep. See the documents in their entirety, including graphs, charts and tables.

5. Claims 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brannon et al., or Hughes et al. (see especially Tables 1-4)..

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Each reference discloses a method that includes a method for removing built-up drill cuttings from a borehole, said method comprising employing a sweep wherein said sweep is selected as the more efficient sweep from a group of sweeps tested in real time at the wellsite using pressure-while-drilling data and calculations of sweep efficiency. With respect to claim 10, the references teach the more efficient sweep is the one that results in the greater recovery of drill cuttings. With respect to claim 11, each reference teaches a real time method for measuring efficiency of a sweep in removing cuttings from a borehole penetrating a subterranean formation, said method comprising: determining the mass in of the sweep; using real time pressure-while-drilling tool data in determining the mass out of the sweep', and subtracting at the borehole site the mass in of the sweep from the mass out of the sweep. See the documents in their entirety, including graphs, charts and tables.

6. Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Allouche et al.

Allouche et al. discloses a method that includes a real time method for measuring efficiency of a sweep in removing cuttings from a borehole penetrating a subterranean formation, said method comprising: determining the mass in of the sweep; using real time pressure-while-drilling tool data in determining the mass out of the sweep', and subtracting at the borehole site the mass in of the sweep from the mass out of the sweep.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 3, 4, 7-9, and 5, respectively of U.S. Patent No. 6,662,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the independent claims of the instant invention has not changed. The applicant merely added the "real time or near real-time" requirements to the instant invention, which were clearly taught by the parent US'884 patent. Further, independent claim 8 of the present invention is a much broader version of claim 5 of the US'884 patent. It would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have included the claims of the instant invention in the US'884 patent in order to gain broadened patent protection

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Strange, Jr. and Sinor teach methods for calculating cutting/drilling efficiency.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zakiya N. Walker
Primary Examiner
Art Unit 3672

ZW
April 15, 2005